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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,142	09/17/2003	Nathaniel P. Langford	54493US011	3488

32692 7590 10/05/2004

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,142

Applicant(s)

LANGFORD, NATHANIEL P.

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>122203</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Prior to the amendment, the highest numbered claim previously presented was claim 23.

Claims 1-23 have been cancelled and misnumbered claims 37-47 have been renumbered 24-34.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "at least than 75 mg/m³" in these claims render the claims indefinite. It is unclear what applicant means by "at least than".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (USPN 4,454,267), Struss et al. (USPN 4,686,253), Patel (USPN 5,653,797) or Smith et al. (USPN 4,286,995).

In col. 2, lines 3-6, col. 3, lines 48-50 and Table I, Williams teaches preparing compositions of joint compounds, which invariably contain a filler and a binder (see col. 1, lines 40-47), by admixing in (including through/uniformly mixing with a Hobart N-50 mixer in examples 1-6) at least one dust reducing additive (as defined in page 4, line 31 to page 5, line 4 and page 6, lines 7-11 of the present specifications), such as wetting agents (surfactant) and water (solvent), wherein the joint compounds are applied to the substrate (a drywall/wallboard joint), allowed to dry and subsequently sanded (see col. 2, lines 27-30).

In col. 3, lines 11-15 and 40-47 and table I, Struss et al. teach processes of preparing joint compounds, essentially containing a filler and a binder, by admixing in at least one dust reducing additives such as wetting agents (surfactant) and water (solvent), wherein the joint compounds are applied to the substrate (a drywall/wallboard joint), allowed to dry, and subsequently sanded (see col. 8, lines 52-55).

In table IV, Struss et al. also teaches the joint compounds to be prepared with the further addition of aminosiloxane compounds, such as SILWET ® L-77 (See col. 6, lines 64-66), which are surface-active compounds (polymeric **surfactants**).

In col. 7, lines 12-15 and Tables I and II, Patel teaches processes of preparing joint compounds, containing fillers and a binders, by admixing in dust-reducing additives as defined in the present specifications (see page 4, line 31 to page 5, lines 4 and page 6, lines 7-11) including water (solvent), wetting agents (surfactants) and a defoamer such as Nopco 9201 (see Table IVA), which according to Smith et al. (see col. 2, line 16 of Smith et al.), is a vegetable oil compound.

In col. 13, lines 60-67, Patel teaches the joint compounds to be applied to substrate such as wallboard joints and subsequently finished (surface abraded) with reduced time and expense.

In the table in col. 2, Smith et al. teaches a joint compound prepared by admixing water (a solvent), 59% of a limestone (filler), 3.20% of a binder comprising a latex (which necessarily comprises water and a surfactant), propylene glycol (a glycol solvent), a vegetable oil defoamer, etc.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1713

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25-29, 33 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Williams or Struss et al.

While Williams or Struss et al., above, do not expressly teach the recited reduced dust generation and/or dust generation properties, it is reasonable that their joints compounds would possess the presently claimed dust reducing properties since the "dust reducing additives", as defined by applicant (see 4, line 31 to page 5, lines 4 and page 6, lines 7-11 **including even materials not fitting into any of the recited categories**), are contained/admixed and treated as presently claimed in the prior art joint compounds and therefore the joint compounds are essentially the same as the joint compounds of applicant's claimed processes. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al., 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Further, even if assuming that the prior art processes do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive process because the disclosure of the inventive subject matter appears within the generic disclosure of Williams or Struss et al.

Art Unit: 1713

8. Claims 24-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Patel or Smith et al.

While Patel or Smith et al., above, do not expressly teach the recited reduced dust generation and/or dust generation properties, it is reasonable that the joint compounds of Patel or Smith et al. would possess the presently claimed dust reducing properties since the "dust reducing additives", as defined by applicant (see 4, line 31 to page 5, lines 4 and page 6, lines 7-11 **including even materials not fitting into any of the recited categories**), are contained/admixed in the prior art joint compounds and therefore the joint compounds are essentially the same as the joint compounds of applicant's claimed processes and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al., 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Further, even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive process because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

9. This is a continuation of applicant's earlier Application No. 09/781,386. All claims are drawn to the same invention claimed in the earlier application and could have been

Art Unit: 1713

finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

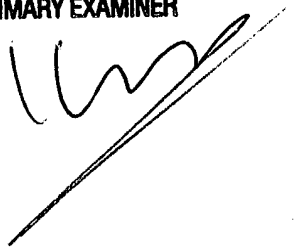
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, consisting of a stylized 'K' followed by a series of loops and a long diagonal stroke extending downwards and to the right.